



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 343355-600028

Group Art Unit: 2173)
Examiner: M. Roswell)
Inventor: Sanders et al.)
Serial No.: 09/837,047)
Filed: April 18, 2001)
For: Graphical User Interface Check-)
List Button Control and Method)

**PRE-APPEAL BRIEF
CONFERENCE REQUEST**

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 31, 2005.

By _____

John Bieracki

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Assignee hereby requests review of the Final Rejection of the above-captioned application prior to filing an appeal brief for the reasons set forth below. The Assignee submits that the Final Rejection is based upon clear errors in fact and fails to establish a *prima facie* rejection.

REASONS FOR PRE-APPEAL CONFERENCE REQUEST

I. PROSECUTION SUMMARY

Independent claims 1, 12 and 17 stand rejected under 35 U.S.C. 102(b) as being anticipated by the Examiner's prior art screenshots of Microsoft Outlook 2000 hereinafter "Outlook." The Assignee traversed these rejections in a Responsive Amendment dated April 5, 2005, on the following grounds.

None of the cited references, either alone or in combination, disclose the second control being displayed and operated within a first control, as recited in independent claims 1, 12 and 17. The Outlook reference relied upon by the Examiner discloses selecting and displaying icons that are spread across Outlook's interface in order to enter calendar items, "to do" items, etc. However the asserted second control of the Outlook reference (i.e., as asserted by the Examiner) is not displayed and does not operate within a first control as required by the independent claims in combination with their respective other limitations.

The Examiner found these arguments unpersuasive and issued a final office action dated June 30, 2005. In the Final Office Action, the Examiner stated:

In response to applicant's argument that Outlook fails to teach a second control configured to be displayed and to operate within a first control (as recited in claims 1, 12, and 17), the Examiner respectfully disagrees. Outlook has been shown *supra* to teach a first control that, upon selection, gives the user access to a second control used in the manipulation of data records. As this second control is accessed through the first control, it inherently operates within the first control. Furthermore, the language of claim 1 states, "wherein the second control is configured to be displayed". The use of this language fails to recite the argued limitation of a second control displayed within a first control. Therefore, claims 1, 12, and 17 are rejected over the Outlook reference for the reasons stated above.

Assignee disagrees with the Examiner's positions. Accordingly, Assignee has filed this paper with the United States Patent Office.

II. CLEAR ERROR IN FACT

The Examiner's interpretation of "wherein the second control is configured" to operate within the first control is clear error in fact. Claim 1's second control operating within the first control plainly means that a person can operate (i.e., manipulate) the second control within the first control. As an

example, figure 2 of applicant's patent application shows a second control 224 operating within a first control 210.

As asserted on page 9 of the Final Office Action, the Examiner maintains that because the second control is accessed through the first control, it inherently operates within the first control. Assignee respectfully disagrees with this position. It does not logically follow that because a second control is accessible through a first control that it inherently operates within the first control. As an example of this, the prior art itself could access a second control through a first control, but the second control would appear elsewhere on the user's screen, such as in a separate window, or as shown in the Outlook reference (e.g., figures 1 and 2 of Outlook), another control would appear in a separate region on the Outlook interface.

This other control in the prior art does not operate within the first control. In other words, a user can access the other control via the first control in the prior art, but the user is not able to operate (i.e., manipulate) the accessed second control within the first control. Just because a user can access a second control via a first control, it is not inherent that the second control operates within the first control since for example the second control could appear in a separate and independent window as in the prior art.

Because of such clear errors, Assignee respectfully requests a favorable reconsideration of this application.

III. FAILURE TO ESTABLISH A PRIMA FACIE REJECTION

In addition to the reasons stated above, the rejection of independent claims 1, 12 and 17 are improper because the Examiner has failed to establish that the cited Outlook reference anticipates each element of the claims. *Inter alia*, the Outlook reference does not describe that a second control is displayed within the first control, as recited in claims 1, 12 and 17.

The Outlook reference relied upon by the Examiner discloses selecting and displaying icons that are spread across Outlook's interface in order to enter calendar items, "to do" items, etc. However the

asserted second control of the Outlook reference (i.e., as asserted by the Examiner) is not displayed within a first control as required by the independent claims in combination with their respective other limitations.

The Examiner maintains that: the language of claim 1 states “wherein the second control is configured to be displayed” and that the use of this language fails to recite the argued limitation of a second control displayed within a first control. The Assignee respectfully disagrees. The independent claims specifically recite that a second control is displayed within a first control:

- Claim 1 recites this aspect: “wherein the second control is configured to be *displayed* and to operate *within the first control*.” (emphasis added)
- Claim 12 recites this aspect: “wherein the second control is configured to be *displayed* and to operate *within the first control*.” (emphasis added)
- Claim 17 recites this aspect: “second computer software instructions to generate a second control that is accessible through the first control and that is *displayed within the first control*.” (emphasis added)

It is noted that the prepositional phrase “within the first control” unambiguously modifies both the “to be displayed” and “to operate” infinitives in claims 1 and 12. Claim 17 recites the verb “displayed” followed directly by the prepositional phrase “within the first control.” Therefore, all of the independent claims recite that the second control is displayed within a first control.

The Outlook reference clearly does not show a second control being displayed (let alone operating) within a first control as required by the independent claims in combination with their other respective limitations. Instead, the asserted second control of the Outlook reference “is presented to the user in the large right panel of Fig. 1” as mentioned in the Final Office Action on page 2. The large right panel region which contains the asserted second control is not being displayed within the asserted first control of Outlook and thus is not being displayed within a first control as required by the independent claims.

The asserted controls of the Outlook reference are strewn across the Outlook interface. This is in stark contrast to the independent claim's approach which in combination with their other limitations recite that the second control is displayed and operates within the first control. This approach of the independent claims allows valuable interface "real estate" to be conserved. This is useful, for example, to interface developers who typically must address limited display space requirements because of the size of computer screens (e.g., PDAs and laptops). With the approach of the independent claims, interface area is significantly better utilized.

Accordingly, the rejection of independent claims 1, 12 and 17 are improper because the Examiner has failed to establish that the cited Outlook reference anticipates each element of the claims.

For the above reasons, Applicant respectfully submits that the pending claims are allowable, and requests the withdrawal of the rejections.

Respectfully submitted,

JONES DAY

By: 

John V. Biernacki

Reg. No. 40,511

JONES DAY

North Point

901 Lakeside Avenue

Cleveland, Ohio 44114

(216) 586-3939